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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/462,911	02/15/00	ROUAU	X 54321.000013

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WASHINGTON DC 20006-1109

HM22/0809

EXAMINER

MELLER, M
ART UNIT PAPER NUMBER

1651
DATE MAILED:

08/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/462,911

Applicant(s)

ROUAU ET AL.

Examiner

Michael V. Meller

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 24-32 have been renumbered under rule 1.26 as claims 26-34 since the application was originally filed with 25 claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's insertion of "other than galactose" in claim 1, raises the issue of new matter. Nowhere in the specification can support be found for this phrase. The specification lists other "oxidizable substrates for the galactose oxidase", but there is no support for excluding galactose in the instant specification.

Further, support for claim 34 cannot be found in the instant specification. There is no support for a compound which is capable of being converted into the substrate for the galactose oxidase.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4, 8-11, 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is no longer needed since applicant has defined the "enzyme having galactose oxidase" activity.

Claim 8 is confusing since it is not clear if both the compound which is an oxidizable substrate for the enzyme having galactose oxidase activity and an oxidizable substrate for the enzyme having galactose oxidase activity are used or if only the compound which is an oxidizable substrate for the enzyme having galactose oxidase activity is used.

Claim 9 is now confusing since applicant has amended it to look like claim 10 (originally filed) is.

Claim 17 is also confusing since it now looks like claim 19 (originally filed) used to. The same is true with claim 19, which now looks like claim 21 (originally filed), same with claim 20 which now looks like claim 22 (originally filed), same with claim 21 which now looks like claim 23 (originally filed), same with claim 22 which now looks like claim 24 (originally filed), and the same with claim 23 which now looks like claim 25 (originally filed).

Claim Rejections - 35 USC § 102

Claims 1, 4, 8, 13-16, 19, 21, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by van der Lugt et al.

Van der Lugt teaches the use of galactose oxidase and stachyose in dough making and discusses the use of them in breadmaking, see entire reference, especially, page 164, page 167 and 170-171. Oxidative agents such as potassium bromate or dehydroascorbic acid is also mentioned.

Claim Rejections - 35 USC § 103

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Somers et al. (Somers) or van der Lugt et al. in view of WO 96/39851 (WO), Banks et al. (Banks) and Clark, Jr. (Clark) for the reasons of record and for the reasons which follow.

Applicant first misstates the teachings of Clark. Clark teaches the equivalency between galactose and lactose as substrates for galactose oxidase, see col. 7-8, the table.

Applicant next argues that the references are improperly combinable. The references cited by the examiner establish what is known in the art. WO, for example, establishes that hemicellulases, cellulase, etc. can be added to dough to improve its properties, see page 16.

Applicant next argues that unexpected results are obtained by the instant invention. Applicant states that they tested monomeric galactose, di-galactose,

arabinogalactan, etc. While this is very interesting, the unexpected results stated have nothing to do with the art cited by the examiner in this rejection. Applicant has not directly shown unexpected results compared to the references cited by the examiner. Until applicant does this, the argument is moot.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Somers et al. (Somers) or van der Lugt et al. in view of WO 94/28728 (WO), Banks et al. (Banks), Clark, Jr. (Clark), Gillmore et al. (Gillmore) and Yokotsuka et al. (Yokotsuka) for the reasons of record and for the reasons which follow.

Applicant has not provided any arguments except to state once again, that the references are not properly combinable. The references cited by the examiner establish what is known in the art. Applicant has not provided any convincing arguments which address why the references are not properly combinable. The references were provided to establish a case of obviousness. The case was met since the references establish that at the time the invention was made, the invention was obvious.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 703-308-4230. The examiner can normally be reached on Monday thru Friday: 10:30am-7:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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MVM
August 8, 2001



DAVID M. NAFF
PRIMARY EXAMINER
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